

REMARKS

This reply is fully responsive to the Office Action dated 01/04/2008, and is filed within five - (5) months following the mailing date of the Office Action. The Commissioner is authorized to treat this response as including a petition to extend the
5 time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed. The method of payment and fees for petition fee due in connection therewith is enclosed.

Disclosure/Claims Status Summary:

- 10 A. Restriction between Invention I and Invention II was required;
B. Claims 7-9 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter;
C. Claims 1-8 and Claim 49 were rejected under 35 U.S.C. §103(a) as being
unpatentable over the Gemmy Allen reference in view of the Forsythe reference;
15 and
D. Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Gemmy Allen reference in view of the Forsythe reference and further in view of the Wall reference.

20 **Restriction**

A. Restriction between Invention I and Invention II was required.

The Examiner required a restriction to one of the following inventions under 35
25 U.S.C. §121:

- I. Claims 1-9, and 49, drawn to providing discounted media placement to a plurality of advertisers including acting as an intermediary, receiving large

block of media, dividing the large block of media, providing smaller blocks of media; and

- II. Claims 10-48, drawn to an internet based method, system, and computer program product for providing discounted internet media placement to a plurality of advertiser including development of jump page and linking to desired websites.

The Applicant hereby elects, without traverse, Invention I, which is represented by Claims 1-9 and 49.

Claim Rejections under 35 U.S.C. §101

- B. Claims 7-9 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claim 7

The Examiner rejected Claim 7 as being directed to non-statutory subject matter, stating that the act of “researching a market in a specific industry” is an abstract idea as it does not provide for a repeatable, tangible, or concrete result.

The Applicant directs the Examiner to currently amended Claim 7. As amended, Claim 7 now claims, “...~~researching a market in~~ selecting a specific industry...” Selecting a specific industry is not abstract and provides for a repeatable, tangible, and concrete result (i.e., the selected specific industry).

Thus, as amended, Claim 7 is directed to statutory subject matter. As such, the Applicant respectfully requests that the Examiner withdraw this rejection.

Claim 8

The Examiner rejected Claim 8, calling into question the use of a “wherein” clause. The term “wherein” is used to identify the portion of the base claim upon which the dependent claim is adding a further limitation. Nevertheless, to address the Examiner’s concern, Claim 8 has been amended to remove the “wherein” language. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection of Claim 8.

Claim 9

The Examiner rejected Claim 9, calling into question the use of a “wherein” clause. The term “wherein” is used to identify the portion of the base claim upon which the dependent claim is adding a further limitation. Nevertheless, to address the Examiner’s concern, Claim 9 has been amended to remove the “wherein” language. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection of Claim 9.

Claim Rejections under 35 U.S.C. § 103

C. Claims 1-8 and Claim 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Gemmy Allen reference in view of the Forsythe reference.

Claim 1

The Examiner rejected Claim 1 as being obvious over the Gemmy Allen reference in view of the Forsythe reference. Upon reviewing the cited prior art, the claim language, and the relevant law, the Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness.

Establishing a *prima facie* case of obviousness requires: (A) determining the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims in issue; (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations. *See Graham v. John Deere*, 383 U.S. 1,

148 USPQ 459 (1966). Proper analysis of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. 35 U.S.C. 103(a). Recently, the Supreme Court stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) quoting *In re Kahn*, 441 F. 3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F. 3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). Importantly, as noted by MPEP 2143.03, to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art.

As applied to the present case, there would be no motivation to combine the prior art as alleged by the Examiner, as the Examiner is attempting to combine distinctly different and non-analogous prior art. The Gemmy Allen reference teaches a retailer purchasing retail goods in bulk, with the Examiner erroneously substituting an advertiser for a retailer. For something to be synonymous and substituted properly, the substitution must work within the concept and meaning of the word. While a retailer can be an advertiser, an advertiser is NOT synonymous with a retailer. An advertiser is someone who uses advertising to promote their business, while a retailer is someone who buys wholesale and sells resale to the consumer. It is not logical to substitute one for the other (as the Examiner attempts to do in the Office Action). For example and to illustrate that the substitution of “retailer” with “advertiser” is inappropriate, the following substitution would simply not work: “The retailer (advertiser) had to pay sales tax on the purchase/sale.” Retailer merchandise is subject to sales tax, advertising is not.

Additionally, stating that a “retailer” and “advertiser” are synonymous simply because a retailer may advertise is similar to stating that a lawyer is synonymous with an advertiser. However, lawyers do not buy in bulk and resell legal services, yet lawyers can also be advertisers.

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In other words, the Gemmy Allen reference teaches a retailer that buys a tangible product in bulk and sells the tangible product in smaller quantities. Buying a tangible retailer product wholesale and selling individual units is common practice. A tangible retail product is extremely different than a service. Thus, the Examiner has erroneously attempted to substitute a retailer for an advertiser to bring relevance to the Gemmy Allen reference. However, a retailer is NOT synonymous with an advertiser and, as such, the substitution is inappropriate. Therefore, contrary to the Examiner’s assertion, the Gemmy Allen reference does NOT teach an advertiser using an intermediary, nor does the Gemmy Allen reference teach buying in bulk and selling smaller blocks of media. Thus, there would be no motivation to combine the cited references as they are non-analogous art.

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Further, it appears that the Forsythe reference was also improperly used. The Examiner stated that the Forsythe reference “teaches the concept of an intermediary between an advertiser or group of advertisers, making wholesale purchases of advertising spots.” This is NOT true. The Forsythe reference teaches the concept of an intermediary between an advertiser and media outlet in order to negotiate better rates for a particular advertiser. While the rates may be negotiated (in the Forsythe reference), nowhere in the cited prior art can be found any reference to acting as an intermediary between a single media provider and a plurality advertisers; receiving a large block of media at a volume-discounted price from a media provider; and dividing the large block of media into a plurality of smaller media blocks (as claimed in Claim 1). The Examiner has attempted to illustrate this concept by citing to online media services. As cited by the Examiner, the “online media service that offers unsold broadcast inventory to media buys at discounted

rates.” In other words, the Forsythe reference teaches negotiating rates based on unsold media, NOT the purchase of large blocks of media and dividing that media amongst a plurality of advertisers.

- 5 In other words, neither the Gemmy Allen reference nor the Forsythe reference teach each element of the claimed limitations of Claim 1. More specifically, assuming arguendo that the Gemmy Allen reference teaches an advertiser and can be combined with the Forsythe reference, neither reference teaches acting as an intermediary between a single media provider and a plurality advertisers; receiving a large block of media at a volume-
10 discounted price from a media provider; and dividing the large block of media into a plurality of smaller media blocks.

- Because neither the Gemmy Allen reference nor the Forsythe reference, either alone or in combination, teach each element of Claim 1, the Applicants respectfully assert that the
15 present invention is patentable over the cited prior art. The Applicants respectfully request that the Examiner withdraw this rejection and provide for timely allowance of Claim 1.

Claims 2 through 8

- 20 Regarding Claims 2 through 8, the Applicants direct the Examiner to the comments above regarding Claim 1. Because neither the Gemmy Allen reference nor the Forsythe reference, either alone or in combination, teach each element of Claim 1, the Applicants respectfully submit that Claims 2 through 8, which depend therefrom, are also allowable at least based in part on their dependency upon an allowable base claim.
25 Therefore, the Applicants respectfully request that the Examiner withdraw this rejection and provide for timely allowance of Claims 2 through 8.

Claim 49

Regarding Claim 49, the Applicants direct the Examiner to the comments above regarding Claim 1 (as Claim 49 includes limitations similar to those of Claim 1). For the reasons as set forth above regarding Claim 1, the Applicants respectfully submit that
5 neither the Gemmy Allen reference nor the Forsythe reference, either alone or in combination, teach each element of Claim 49. Thus, the Applicants respectfully assert that the present invention is patentable over the cited prior art and respectfully request that the Examiner withdraw this rejection and provide for timely allowance of Claim 49.

10 D. Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Gemmy Allen reference in view of the Forsythe reference and further in view of the Wall reference.

Regarding Claim 9, the Applicants direct the Examiner to the comments above regarding
15 Claim 1. Because neither the Gemmy Allen reference, the Forsythe reference, nor the Wall reference, either alone or in combination, teach each element of Claim 1, the Applicants respectfully submit that Claim 9, which depends therefrom, is also allowable at least based in part on its dependency upon an allowable base claim. Therefore, the Applicants respectfully request that the Examiner withdraw this rejection and provide for
20 timely allowance of Claim 9.

CONCLUSION

The Applicants respectfully submit that in light of the above amendment/remarks, all claims are now in allowable condition. The Applicants thus respectfully request timely
5 allowance of all of the pending claims.

Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather,
10 these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply additional specific statements of
15 inventive concepts described in the application as originally filed.

Further, it should be noted that amendment(s) to any claim is intended to comply with the requirements of the Office Action in order to elicit an early allowance, and is not intended to prejudice Applicants' rights or in any way to create an estoppel preventing
20 Applicants from arguing allowability of the originally filed claim in further off-spring applications.

In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicants or Applicants' representative would be beneficial, the
25 Examiner is encouraged to contact the undersigned at the telephone number indicated below.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to the attached credit card form. In particular, if this response is not

timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. 50-2738 if a credit card
5 form has not been included with this correspondence, or if the credit card could not be charged.

Respectfully submitted,



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